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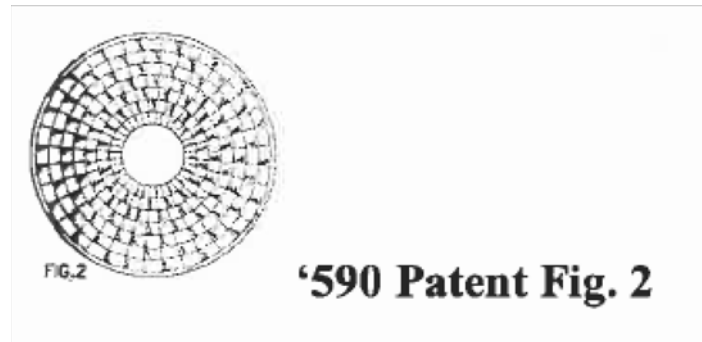
UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

|    |                             |   |   |
|----|-----------------------------|---|---|
| 11 | GRAND GENERAL ACCESSORIES   | ) | Case No. CV 08-07078 DDP (VBKx)         |
| 12 | MANUFACTURING, a California | ) |   |
| 13 | corporation,                | ) | <b>Order (1) Granting Defendants'</b>   |
| 14 |                             | ) | <b>Motion for Summary Judgment in</b>   |
| 15 | Plaintiff,                  | ) | <b>Part (Dkt. No. 111); (2) Denying</b> |
| 16 |                             | ) | <b>Plaintiff's Motion for Summary</b>   |
| 17 | v.                          | ) | <b>Judgment in Part (Dkt. No. 103)</b>  |
| 18 |                             | ) |   |
| 19 | UNITED PACIFIC INDUSTRIES   | ) |   |
| 20 | INC., a California          | ) | [Motions filed on May 28, 2010]         |
| 21 | corporation; LUCIDITY       | ) |   |
| 22 | ENTERPRISE CO., LTD., a     | ) |   |
| 23 | corporation of Taiwan,      | ) |   |
| 24 |                             | ) |   |
| 25 | Defendants.                 | ) |   |
| 26 |                             | ) |   |

Before the Court is Plaintiff Grand General Accessories Manufacturing ("GGAM")'s Motion for Summary Judgment as to patent validity, patent infringement, and trade dress infringement, and Defendants United Pacific Industries, Inc. ("UPI") and Lucidity Enterprise Co. ("Lucidity") (together "Defendants")' Motion for Summary Judgment on all claims.

Plaintiff owns a number of design patents related to automotive stop/tail/turn ("S/T/T") lights. The feature uniting GGAM's line of S/T/T lights is a light bulb reflector that the parties refer to as the "web comb design." The design consists of

multiple facets arranged in a grid-like manner on the inner surface of a parabolic reflector, with a light bulb resting in the center of the reflector. GGAM claimed the web comb design (displayed below) in U.S. Design Patent No. 463,590 (the "'590 Patent"), issued in 2002.



According to GGAM, its entire series of S/T/T lights is an expansion of the basic design disclosed in the '590 Patent (described in the application as a "[r]ound decorative vehicle lighting reflector with segmented reflective surface.")<sup>1</sup> (Pl.'s Second Am. Compl. ("SAC") ¶ 17.) The '590 Patent itself is not directly at issue in this case; Plaintiffs instead accuse Defendants of infringing seven separate S/T/T design patents that make use of the web comb design (and one additional non-S/T/T light design patent). Plaintiffs also allege trade dress infringement under the Lanham Act.

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<sup>1</sup> Although Plaintiff acknowledges that each of its S/T/T light design patents incorporate the basic web comb design disclosed in the '590 Patent, its expert contends that the designs are distinguishable from the '590 Patent because "they are all associated with the use of multiple LED sources and multiple reflectors," and the '590 Patent "discloses a single faceted reflector utilizing a single incandescent bulb." (Jiao Opp'n Decl. ¶ 4.)

For the reasons explained below, the Court is persuaded that Defendants are entitled to summary judgment in their favor on the grounds of patent invalidity with respect to five of Plaintiff's design patents, and on Plaintiff's trade dress infringement claim. Accordingly, the Court DENIES Plaintiff's Motion for Summary Judgment in part, and GRANTS Defendants' Motion for Summary Judgment in part. In a separate, concurrently filed order, the Court directs the parties to file supplemental briefing addressing invalidity and infringement issues related to the three design patents-in-suit that the Court does not declare invalid in this order.

#### **I. Background**

Since 2002, Plaintiff has created a series of S/T/T lights incorporating the basic web comb design, and each design has a corresponding design patent. (SAC ¶ 16.) The disputed patents are listed below, along with the drawings submitted in the respective patent applications:

1) 570,012 ("'012 Patent") - "low profile round LED sealed light with spider design" - filed November 6, 2007; issued May 27, 2008 (Pl.'s Statement of Uncontroverted Facts ("SUF") ¶ 13; Rozsa Decl. Ex. 7);

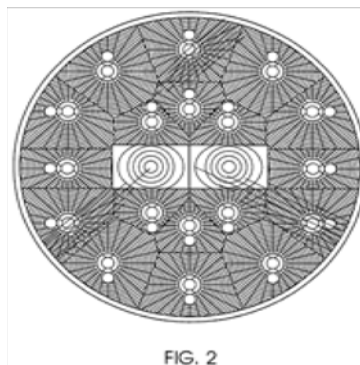
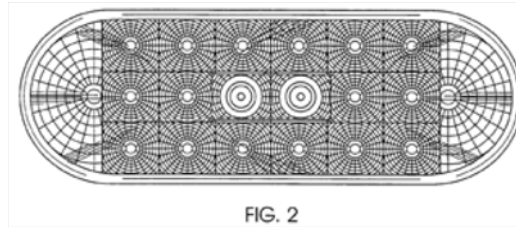
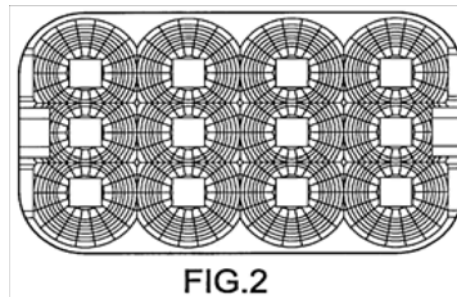


FIG. 2

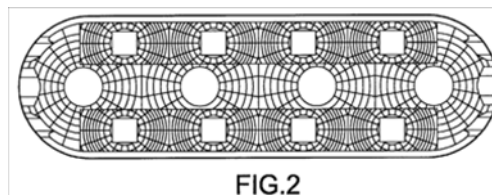
1           2) 570,013 ("013 Patent") - "low profile oval LED sealed  
2 light with spider design" - filed November 6, 2007; issued May, 27,  
3 2008 (Pl.'s SUP ¶ 15; Rozsa Decl. Ex. 8);  
4



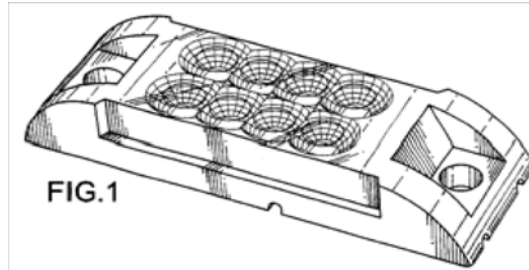
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9           3) 474,303 ("303 Patent") - "rectangular decorative reflector  
10 for vehicle light with multiple LEDs" - filed September 26, 2002;  
11 issued May 6, 2003, (Pl.'s SUP ¶ 7; Rozsa Decl. Ex. 3);  
12



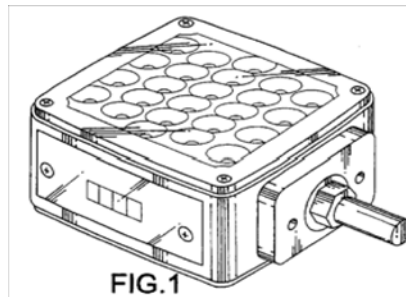
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18           4) 474,559 ("559 Patent") - "oval decorative reflector for  
19 vehicle light with multiple LEDs" - filed September 24, 2002;  
20 issued May 13, 2003 (Pl.'s SUP ¶ 9; Rozsa Decl. Ex. 4);  
21  
22



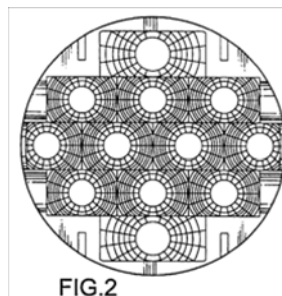
1           5) 507,670 ("670 Patent") - "rectangle multi-LED spider  
2 marker light for vehicle" - filed November 22, 2004; issued July  
3 19, 2005 (Pl.'s SUF ¶ 11; Rozsa Decl. Ex. 5);



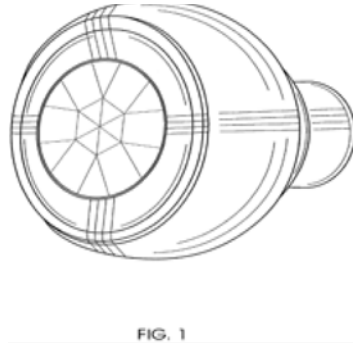
10           6) 511,850 ("850 Patent") - "square multi-LED spider marker  
11 light for vehicle" - filed November 22, 2004; issued November 22,  
12 2005 (Pl.'s SUF ¶ 17; Rozsa Decl. Ex. 9)



20           7) 470,970 ("970 Patent") - "round decorative vehicle  
21 reflector for vehicle light with multiple LEDs" - filed September  
22 24, 2002; issued February 25, 2003 (Pl.'s SUF ¶ 5; Rozsa Decl. Ex.  
23 8);



1  
2  
3 8) 548,038 ("038 Patent") - "screw-in knob with fanciful  
4 design" - filed June 3, 2006; issued August 7, 2007 (Pl.'s SUP ¶  
5 19; Rozsa Decl. Ex. 10);



12  
13 The first seven patents are vehicle S/T/T or marker lights  
14 that rely on a multiplicity of faceted reflectors and an LED light  
15 in each reflector set to create the web comb effect. The eighth  
16 patent (the '038 Patent) is an air valve knob with a diamond  
17 faceted jewel; the jewel being the sole ornamental aspect of the  
18 knob. (Pl.'s SUP ¶¶ 123-25.)

19 Plaintiff alleges that Lucidity copied Plaintiff's patented  
20 designs with the intention of duplicating its products. (SAC ¶ 37.)  
21 It alleges that it became aware that Lucidity and Defendant United  
22 Pacific Industries, Inc. ("UPI") were selling decorative vehicle  
23 lights that infringed its design patents sometime in 2008. (SAC ¶¶  
24 46-47.) The patents and products related to those patents are too  
25 numerous to describe here (they comprise approximately fifty pages  
26 of Plaintiff's SAC).

27 In October 2008, GGAM filed suit against Defendants for patent  
28 infringement, trade dress infringement, and various other causes of

1 action. In June and July of 2009, UPI and Lucidity counterclaimed  
2 against GGAM, raising various affirmative defenses. On May 28,  
3 2010, GGAM moved for summary judgment as to patent validity, patent  
4 infringement, and trade dress infringement, and Defendants filed a  
5 cross-motion for summary judgment on all claims. The Court heard  
6 oral argument on August 6, 2010.

## 7 **II. Legal Standard**

8 Summary judgment, in patent as in other cases, is proper when  
9 there is no genuine issue of material fact and the moving party is  
10 entitled to judgment as a matter of law. Hodosh v. Block Drug Co.,  
11 Inc., 786 F.2d 1136, 1141 (Fed. Cir. 1986). The moving party bears  
12 the burden of demonstrating the absence of any genuine issue of  
13 material fact, and all justifiable inferences must be resolved in  
14 the light most favorable to the nonmovant. Celotex Corp. v.  
15 Catrett, 477 U.S. 317, 322-23 (1986). However, the moving party  
16 need not disprove matters on which the nonmovant will have the  
17 burden of proof at trial. Id. at 322.

18 The movant can meet its burden by demonstrating "that there is  
19 an absence of evidence to support the nonmoving party's case," thus  
20 shifting the burden to the nonmovant to prove otherwise. Id. at  
21 325. However, "[t]o create a genuine issue of fact, the nonmovant  
22 must do more than present some evidence on an issue it asserts is  
23 disputed." Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc., 853  
24 F.2d 1557, 1560 (Fed. Cir. 1988). Rather, the nonmovant must  
25 provide "specific facts showing that there is a genuine issue for  
26 trial." Fed. R. Civ. P. 56(e). If, instead, the nonmovant's  
27 evidence is "merely colorable, or is not significantly probative,

28

1 summary judgment may be granted." Anderson v. Liberty Lobby, Inc.,  
2 477 U.S. 242, 249-50 (1986).

3 It is not the Court's task "to scour the record in search of a  
4 genuine issue of triable fact." Keenan v. Allan, 91 F.3d 1275,  
5 1278 (9th Cir. 1996). Counsel have an obligation to lay out their  
6 support clearly. Carmen v. San Francisco Sch. Dist., 237 F.3d 1026,  
7 1031 (9th Cir. 2001). The Court "need not examine the entire file  
8 for evidence establishing a genuine issue of fact, where the  
9 evidence is not set forth in the opposition papers with adequate  
10 references so that it could conveniently be found." Id.

### 11 **III. Discussion**

#### 12 **A. Design Patent Infringement**

13 "Whoever invents any new, original and ornamental design for  
14 an article of manufacture may obtain a patent therefor, subject to  
15 the conditions and requirements of this title." 35 U.S.C. § 171.  
16 "As the statute indicates, a design patent is directed to the  
17 appearance of an article of manufacture." PHG Tech., LLC v. St.  
18 John Cos., 469 F.3d 1361, 1366 (Fed. Cir. 2006). "If the patented  
19 design is primarily functional rather than ornamental, the patent  
20 is invalid." Power Controls Corp. v. Hybrinetics, Inc., 806 F.2d  
21 234, 238 (Fed. Cir. 1986).

22 "The starting point for any discussion of the law of design  
23 patents is the Supreme Court's decision in Gorham Co. v. White, 14  
24 Wall. 511, 81 U.S. 511 (1871)." Egyptian Goddess, Inc. v. Swisa,  
25 Inc., 543 F.3d 665, 670 (Fed. Cir. 2008). In Gorham, the Court  
26 explained that the test for design patent infringement "must be  
27 sameness of appearance, and mere difference of lines in the drawing  
28 or sketch . . . or slight variances in configuration will not



1 destroy the substantial identity." 81 U.S. at 526-27. "Identity  
2 of appearance, the [Gorham] Court explained, or 'sameness of effect  
3 upon the eye, is the main test of substantial identity of design';  
4 the two need not be the same 'to the eye of an expert,' because if  
5 that were the test, '[t]here never could be piracy of a patented  
6 design, for human ingenuity has never yet produced a design, in all  
7 its details, exactly like another, so like, that an expert could  
8 not distinguish them.'" Id. (quoting Gorham, 511 U.S. at 527).

9 The Federal Circuit has made clear that the "ordinary  
10 observer" test is the sole test for determining whether a design  
11 patent has been infringed. Egyptian Goddess, 543 F.3d at 678.  
12 "Under that test . . . infringement will not be found unless the  
13 accused article 'embod[ies] the patented design or any colorable  
14 imitation thereof.'" Id. (quoting Goodyear Tire & Rubber Co. v.  
15 Hercules Tire & Rubber Co., 162 F.3d 1113, 1116-17 (Fed. Cir.  
16 1998)).

17 The Supreme Court has long held that a design is better  
18 represented by an illustration "than it could be by any description  
19 and a description would probably not be intelligible without the  
20 illustration." Dobson v. Dornan, 118 U.S. 10, 14 (1886).  
21 Accordingly, "[i]n many cases, the considerable effort in  
22 fashioning a detailed verbal description does not contribute enough  
23 to the infringement analysis to justify the endeavor." Crocs, Inc.  
24 v. Int'l Trade Comm'n, 598 F.3d 1294, 1302 (Fed Cir. 2010).

#### 25 1. Invalidity

26 The Court first takes up Defendants' argument that Plaintiff's  
27 patents are invalid. "By direction of 35 U.S.C. § 282, an issued  
28 patent is presumed valid." KSR Int'l Co. v. Teleflex, Inc., 550

1 U.S. 398, 412 (2007). Accordingly, "a moving party seeking to  
2 invalidate a patent at summary judgment must submit such clear and  
3 convincing evidence of facts underlying invalidity that no  
4 reasonable jury could find otherwise." SRAM Corp. v. AD-II Eng'g,  
5 Inc., 465 F.3d 1351, 1357 (Fed. Cir. 2006).

6 a. *On sale bar*

7 An inventor loses his or her right to a patent if the  
8 invention was "on sale in this country, more than one year prior to  
9 the date of the application for patent in the United States." 35  
10 U.S.C. § 102(b). The party asserting the on sale bar must  
11 demonstrate by clear and convincing evidence that there was a  
12 definite sale or offer to sell more than one year before the patent  
13 application. Ferag AG v. Quipp, Inc., 45 F.3d 1562, 1566 (Fed.  
14 Cir. 1995). "A single sale or offer is enough to bar  
15 patentability," but mere preparation for sale is insufficient.  
16 Intel Corp. v. U.S. Int'l Trade Comm'n, 946 F.2d 821, 830 (Fed.  
17 Cir. 1991). Moreover, the overall appearance of the prior  
18 invention must be virtually identical to the design of the  
19 challenged patent. Keystone Retaining Wall Sys. v. Westrock, Inc.,  
20 997 F.2d 1444, 1451-52 (Fed. Cir. 1993). Finally, the ultimate  
21 determination that a product was placed on sale, although based on  
22 the underlying facts, is a question of law. Id. at 1451.

23 The Court is persuaded that the '038, '012, and '013 Patents  
24 are invalid pursuant to the on sale bar.

25 '038 Patent

26 The '038 patent covers an air-valve knob with a faceted jewel.  
27 The jewel is the sole ornamental aspect of the product. Defendant  
28

UPI has been selling a knob strikingly similar to one disclosed in the '038 Patent (issued in 2008) since 2004.



UPI's 2004  
Product

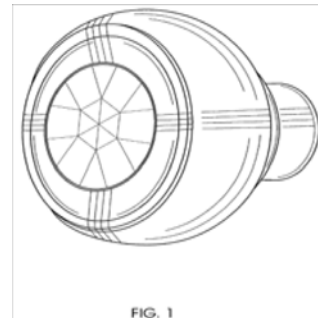


FIG. 1  
'038 Patent

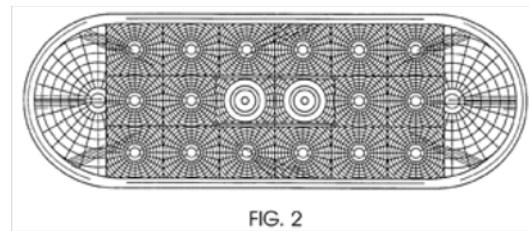
UPI produced a copy of their 2004 catalog, which shows a product in all relevant respects virtually identical to the one disclosed in the '038 design patent being offered for sale, along with an inventory history report stating that UPI had the cataloged item in their warehouse at that time. (Lin Decl. Ex. 3.)<sup>2</sup> Accordingly, the '038 Patent is invalid pursuant to 35 U.S.C. § 102(b).

#### '012 Patent

The '012 Patent is also invalid under 35 U.S.C. § 102(b). Plaintiff was offering the product displayed below for sale as far back as 2005 (the '012 Patent, issued in May 2008, is also displayed for comparison):

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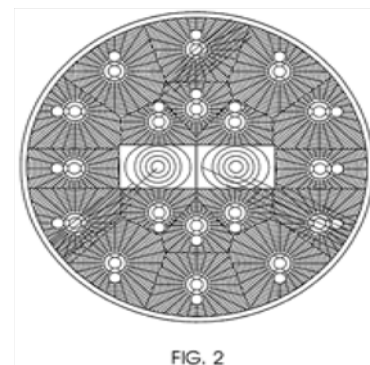
<sup>2</sup> Plaintiff does not address this evidence other than to submit that Defendants' evidence (the catalogues and product inventory logs) was not disclosed in a timely manner and therefore should not be considered. (Pl.'s Mem. of P. & A. in Opp'n, 5:11-17.) Plaintiff has not, however, filed a motion for discovery sanctions, which would be the appropriate course of action under Central District Local Rules. C.D. CAL. L.R. 37-4.



The product that Plaintiff began offering for sale in 2005 is in all relevant respects virtually identical to the design disclosed in the '012 Patent. Accordingly, the patent is invalid pursuant to the on sale bar.

#### '013 Patent

Plaintiff was offering the product displayed below for sale as far back as 2005 (the '013 Patent, application filed in November 2007, is also displayed for comparison):



1 The product that Plaintiff began offering for sale in 2005 is  
2 in all relevant respects virtually identical to the design  
3 disclosed in the '013 Patent. Accordingly, the patent is invalid  
4 pursuant to the on sale bar.

5 b. *Obviousness*

6 Defendants also contend that Plaintiff's design patents are  
7 invalid because "the subject matter as a whole would have been  
8 obvious at the time the invention was made to a person having  
9 ordinary skill in the art to which said subject matter pertains."  
10 35 U.S.C. § 103(a) (1995). The Supreme Court has summarized the  
11 obviousness bar as follows:

12 If a person of ordinary skill can implement a predictable  
13 variation, § 103 likely bars its patentability. For the same  
14 reason, if a technique has been used to improve one device,  
15 and a person of ordinary skill in the art would recognize  
that it would improve similar devices in the same way, using  
the technique is obvious unless its actual application is  
beyond his or her skill.

16 KSR Int'l Co. v. Teleflex, 550 U.S. 398, 417 (2007).

17 The obviousness analysis requires the Court to determine: (1)  
18 the scope and content of the prior art; (2) the differences  
19 between the prior art and the claims at issue; and (3) the level of  
20 ordinary skill in the pertinent art. Graham v. John Deere Co., 383  
21 U.S. 1, 17 (1966). In addition, secondary considerations such as  
22 commercial success, licensing to third parties, and unpermitted  
23 copying can provide evidence that a design was not obvious.  
24 Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, 45 F.3d  
25 1550, 1555 (Fed. Cir. 1995). In the end, however, the obviousness  
26 of a design is a conclusion of law, based upon factual  
27 underpinnings. Jurgens v. McKasy, 927 F.2d 1552, 1558 (Fed. Cir.  
28 1991).

1       The first step in the analysis is to determine "whether there  
2 is a reference to something in existence, the design  
3 characteristics of which are basically the same as the claimed  
4 design." L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117,  
5 1124 (Fed. Cir. 1993) (internal citations omitted). These prior  
6 art references may take the form of other patents, printed  
7 publications, or actual items which were in public use more than  
8 one year prior to the contested patent application. In re Harvey,  
9 12 F.3d 1061, 1065 (Fed. Cir. 1993). Such references must have  
10 existed at the time of invention, and hindsight may not be used to  
11 determine that the challenged design was obvious. Id. Moreover,  
12 in conducting this analysis, the court must look at the design as a  
13 whole, rather than merely referencing its component parts. Id. If  
14 the prior art merely suggests "components of the [challenged]  
15 design, but not its overall appearance, an obviousness rejection is  
16 inappropriate." Id. at 1063.

17       For design patents, obviousness is determined from the vantage  
18 of the "designer of ordinary skill or capability in the field to  
19 which the design pertains." L.A. Gear, 988 F.2d at 1124. This  
20 hypothetical designer is presumed to have perfect knowledge of all  
21 pertinent prior art. The subjective knowledge of particular  
22 designers is not controlling. Tveter v. AB Turn-O-Matic, 633 F.2d  
23 831, 834 (9th Cir. 1980). When analyzing this factor, courts may  
24 consider "opinion testimony by experts concluding that an invention  
25 would or would not have been obvious." Petersen Mfg. Co. v.  
26 Central Publ'g, Inc., 740 F.2d 1541, 1548 (Fed. Cir. 1984).  
27 However, such opinions do not necessarily preclude the grant of  
28

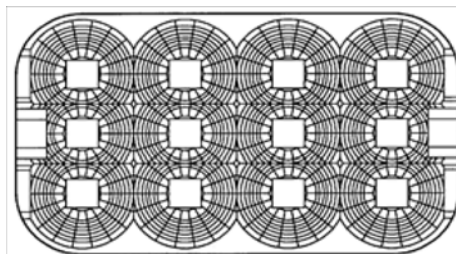
1 summary judgment against the offering party because the obviousness  
2 of a design is a question of law for the court to resolve. Id.

3 Finally, objective evidence such as commercial success,  
4 unpermitted copying, or licensing agreements with third parties is  
5 relevant to the question of a design's obviousness and must be  
6 considered. Glaverbel, 45 F.3d at 1555.

7 The Court is persuaded that the '850 and '670 Patents are  
8 invalid pursuant to the obviousness bar.

9 The '670 and '850 Patents combine well-known S/T/T housing  
10 templates with an array of LED bulbs, each situated in the center  
11 of a web comb reflector. In light of the '303 Patent, the later-  
12 in-time '670, '850, and Patents would be obvious to a designer of  
13 ordinary skill in the art; or indeed, to any ordinary observer:

14  
15 **'303 Patent (issued 2003)**



21 **FIG.2**

22 The '670 Patent is an obvious reformulation of the above  
23 design, tweaked to fit in a style of S/T/T housing that was  
24 indisputably a component of the prior art.<sup>3</sup> The only discernable  
25 difference is the number of bulbs. The Court is persuaded,  
26 however, that a designer with ordinary skill would have found the

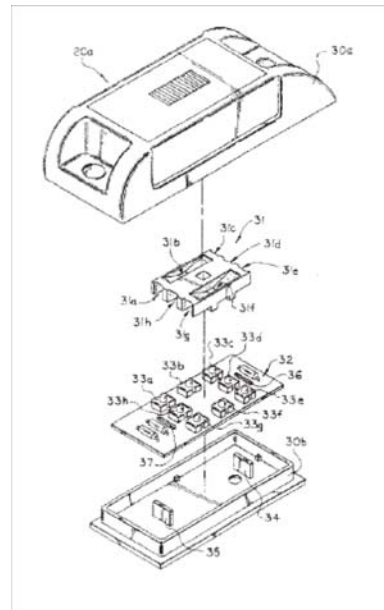
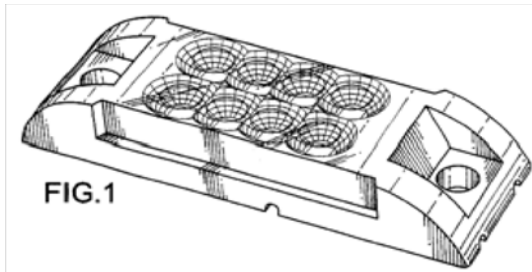
27 \_\_\_\_\_  
28 <sup>3</sup> Plaintiff did not disclose the '303 Patent as prior art  
in its application for the '670 Patent.



1 addition of an additional row of four bulbs to be an obvious  
2 extension of the prior art.

3  
4 **'670 Patent**

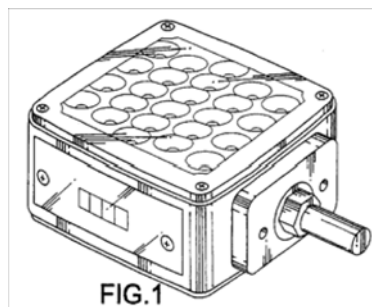
**U.S. Patent No. 6,095,663 (filed 1997)**



16 The '850 Patent is a similarly obvious application of the web  
17 comb design to a previously established style of S/T/T housing:

18 **'850 Patent**

**NAPA S/T/T Light (on sale in 1999)**





1 Plaintiff relies on the testimony of its expert, Dr. Jianzhong  
2 Jiao, an engineer with extensive experience in the automotive  
3 lighting sphere, to rebut Defendants' obviousness evidence. Dr.  
4 Jiao's testimony is insufficient to create a genuine issue of  
5 material fact with respect to the '670 and '850 Patents. In  
6 defending the non-obviousness of Plaintiff's designs, Dr. Jiao  
7 offers only conclusory assertions regarding the overall visual  
8 impression that Plaintiff's products convey. The following is  
9 typical of his testimony:

10 An LED light source is a prior art, a faced[sic] reflector is  
11 a prior art, and a round, square, oval[sic] shape automotive  
12 lamp is prior art. However, combining LEDs, faceted  
13 reflectors and arranging them in the particular configuration  
in a given shape automotive lamp to achieve unique lit and  
unlit visual ornamental characteristics is certainly  
patentable.

14 (Jiao Opp'n Decl. ¶ 7.) As Dr. Ziao acknowledges, the web comb  
15 faceted reflector design and the various forms of S/T/T light  
16 housing are indisputable components of the prior art. As are, of  
17 course, LED light sources. Dr. Ziao contends, however, that the  
18 arrangement of the bulbs and reflectors into a "particular  
19 configuration" produces "unique visual characteristics." (Id.)  
20 With respect to the '850 and '670 Patents, the Court is  
21 unpersuaded. The unique characteristics that Plaintiff stresses  
22 amount to obvious, straightforward arrangements of bulbs and  
23 refelctors into identical rows. By Plaintiff's logic, any number  
24 of LED bulbs and reflectors (e.g., twelve instead of fourteen, four  
25 rows of three instead of three rows of fours) would be non-obvious  
26 and thus patentable because of each arrangements unique visual  
27 characteristics. This is not the law. Accordingly, the Court  
28 concludes that the '670 and '850 Patents are invalid in light of

1 the '303 Patent and the other prior art in the summary judgment  
2 record.<sup>4</sup>

3 **B. Trade Dress Infringement**

4 Plaintiff filed suit for trade dress infringement under  
5 Section 43(a) the Lanham Act. See 15 U.S.C. § 1125(a). The Act  
6 states, in relevant part:

7 (1) Any person who, on or in connection with any goods or  
8 services . . . uses in commerce any word, term, name, symbol,  
9 or device, or any combination thereof, or any false  
designation of origin, false or misleading description of  
fact, or false or misleading representation of fact, which--

10 (A) is likely to cause confusion, or to cause mistake, or to  
11 deceive as to the affiliation, connection, or association of  
12 such person with another person, or as to the origin,  
sponsorship, or approval of his or her goods, services, or  
commercial activities by another person, or

13 (B) in commercial advertising or promotion, misrepresents the  
14 nature, characteristics, qualities, or geographic origin of  
15 his or her or another person's goods, services, or commercial  
16 activities, shall be liable in a civil action by any person  
who believes that he or she is or is likely to be damaged by  
such act.

17 15 U.S.C. § 1125(a).

18 "Trade dress refers generally to the total image, design, and  
19 appearance of a product and may include features such as size,  
20 shape, color, color combinations, texture or graphics." Clicks  
21 Billiards, Inc. v. Sixshooters, Inc., 251 F.3d 1252, 1258 (9th Cir.  
22 2001). "Distinctiveness is . . . an explicit prerequisite for  
23 registration of trade dress . . . ." Wal-Mart Stores, Inc. v.  
24 Samara Bros., Inc., 529 U.S. 205, 210 (2000). The Lanham Act also  
25 "require[s] that a producer show that the allegedly infringing

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26  
27 <sup>4</sup> Because the Court concludes that the '670, '850, '012,  
28 '013, and '038 Patents are invalid, it does not reach Defendants'  
anticipation and inequitable conduct affirmative defenses, or their  
arguments regarding non-infringement.

1 feature is not 'functional' . . . and is likely to cause  
2 confusion." Id.

3 For the reasons explained below, the Court is persuaded that  
4 Plaintiff has not produced competent evidence establishing the  
5 distinctiveness element of its trade dress infringement claim, and  
6 thus, that Defendants are entitled to summary judgment.

7 Distinctiveness is established by "any word, term, name,  
8 symbol, or device, or any combination thereof . . . which . . . is  
9 likely to cause confusion . . . as to the origin, sponsorship, or  
10 approval of his or her goods . . . ." Wal-Mart Stores, Inc. v.  
11 Samara Bros., Inc., 529 U.S. 205, 209 (2000).

12 Trade dress protection was traditionally applied only to a  
13 product's packaging, but the doctrine has been expanded to include  
14 the design of a given product as well. The standard for  
15 establishing distinctiveness, however, differs for the two types of  
16 trade dress. Product design trade dress is "protectible only upon  
17 a showing of secondary meaning," Wal-Mart, 529 U.S. at 216,  
18 whereas, other forms of trade dress can be protected when they are  
19 inherently distinctive or if they acquire secondary meaning.  
20 Plaintiff, here, alleges product design trade dress, and thus it  
21 must establish secondary meaning.

22 Secondary meaning can be established through direct evidence  
23 (i.e., consumer surveys and testimony), or circumstantially through  
24 "exclusivity, manner, and length of use of a mark; amount and  
25 manner of advertising; amount of sales and number of customers;  
26 established place in the market; and proof of intentional copying  
27 by the defendant." Filipino Yellow Pages, Inc. v. Asian Journal  
28 Publ'n, Inc., 198 F.3d 1143, 1151 (9th Cir. 1999).

1 Plaintiff claims that the lamp's web comb design has become  
2 associated with GGAM and has secondary meaning. (Pl.'s SUF ¶ 52.)  
3 Upon careful review of the record, the Court concludes that  
4 Plaintiff has provided no direct evidence (consumer testimony or  
5 surveys) regarding an established secondary meaning. Plaintiff has  
6 provided one article and declarations from its own employees. The  
7 testimony from Plaintiff's employees has very limited probative  
8 value. Filipino Yellow Pages, 198 F.3d at 1152 (explaining that  
9 self-serving statements from a litigant's own employees carry  
10 little weight); see Self-Realization Fellowship Church v. Ananda  
11 Church of Self-Realization, 59 F.3d 902, 910 (9th Cir. 1995)  
12 (concluding that declarations from a trademark plaintiff's  
13 employees and wholesalers had "little probative value regarding the  
14 assessment of consumer perception" because "[t]rademark law is  
15 skeptical of the ability of an associate of a trademark holder to  
16 transcend personal biases to give an impartial account of the value  
17 of the holder's mark"). The article Plaintiff relies on provides  
18 little information about consumer behavior beyond noting that  
19 Plaintiff's product is a hot seller, and it does not reference  
20 Plaintiff's design or its connection to the mark. Even if the  
21 article offered more in the way of substance, "[t]estimony from a  
22 single source is insufficient to demonstrate secondary meaning."  
23 See Art Attacks Ink, LLC v. MGA Entm't. Inc., 581 F.3d 1138, 1146  
24 (9th Cir. 2009).

25 Plaintiff also asserts that secondary meaning can be  
26 established through exclusivity, manner, and length of use because  
27 they were the first to introduce S/T/T lights into the market with  
28 the specific web comb design. (Huang Decl. ¶ 21.) Defendants

1 persuasively counter that as many as eight other companies are  
2 selling similar products (including two competing products that  
3 employ the specific web-comb design), there was no consistent  
4 manner because the lighting pattern is not the same throughout the  
5 product line, and even assuming Plaintiff has been selling web  
6 comb-based products for a significant period of time, secondary  
7 meaning was not established at any point.

8 Plaintiff states that it has spent over \$500,000.00 in  
9 advertising their "Spyder" line of products, and that this  
10 advertising effort supports a finding of secondary meaning. (Pl.'s  
11 SUF ¶ 68.) Advertising is relevant, but "the true test of  
12 secondary meaning is the effectiveness of the advertising effort."  
13 Art Attacks, 581 F.3d at 1146 (internal quotations omitted).  
14 Plaintiff has provided no evidence of the effectiveness of their  
15 advertising in creating a secondary meaning other than providing  
16 the dollar figure of their advertising budget, which has little  
17 meaning without context.

18 Amount of sales, customers, and an established place in the  
19 market can also be evidence of secondary meaning. The evidence  
20 that Plaintiff provides (raw sales figures), however, has limited  
21 value without further details regarding market and competitor sales  
22 figures.

23 Plaintiff also alleges that Defendant intentionally copied  
24 their designs by sending employees to trade shows to photograph  
25 Plaintiff's products, and to use the pictures to make duplicate  
26 products. (Pl.'s SUF ¶¶ 55, 65.) The incidents, however, are only  
27 recounted by Plaintiff's employees without any corroborating  
28 evidence, and are strongly disputed by Defendant. (Defs.' SIMF 55,

65.) Regardless, the alleged incidents are not sufficient on their own to establish secondary meaning.

In sum, Plaintiff has failed to provide clear and convincing evidence of secondary meaning, and thus, their motion for summary judgment on their trade dress infringement claim must be denied. Defendants have shown that there is no triable issue regarding secondary meaning, and accordingly, the Court grants their motion for summary judgment on Plaintiff's trade dress infringement claim.

#### **IV. Conclusion**

For the reasons set forth above, the Court GRANTS Defendants' Motion for Summary Judgment in part, and DENIES Plaintiff's Motion for Summary Judgment in part. The Court withholds ruling on the patent invalidity and patent infringement issues related to the '303, '970, and '559 Patents. In a separate, accompanying order, the Court directs the parties to file supplemental briefing addressing several issues related to the '303, '970, and '559 Patents.

IT IS SO ORDERED.

Dated: August 9, 2010

  
DEAN D. PREGERSON  
United States District Judge